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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/710,540

07/20/2004

George Pieczenik

4539

30576 7590 02/13/2008

DR. GEORGE PIECZENIK
APT. 1F
412 EAST 55TH STREET
NEW YORK, NY 10022

EXAMINER

LEMIEUX, JESSICA

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

02/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/710,540	Applicant(s) PIECZENIK, GEORGE	
	Examiner JESSICA L. LEMIEUX	Art Unit 4172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/20/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The signature is improper as it's in improper electronic form and is also missing the date.

Specification

2. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

The abstract of the disclosure is objected to because it is not directed to the entire disclosure. Correction is required. See MPEP § 608.01(b).

Claim Objections

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim [c1] been renumbered 1.

Misnumbered claim [c2] been renumbered 2.

Misnumbered claim [c3] been renumbered 3.

Misnumbered claim [c4] been renumbered 4.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims lack structures or means for performing any specific functions. These claims recite intended results having no means or steps or structures for performing any desired results, and thus fail to provide enabling means or steps for performing specific functions.

Furthermore, it is unclear how to make the claimed invention. No detailed explanation is provided regarding how to present all stocks from all stock exchanges and how to convert by the electronic trading system all foreign stocks from all foreign exchanges into their dollar equivalent.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 1-4 it is unclear whether the claims are directed toward a system claim, a method claim, an apparatus claim or a process of manufacturing. The claims appear to be narrative and recite intended results. If an apparatus or system claim is desired, then the Examiner suggests applicant to recited means for or structural language for performing the desired functions. If a method claim is desired, then the Examiner suggests applicant to introduce a series of discrete steps to performing desired functions.

What is a novel commercial paper document?

As to claim 4, "allowing" is a bit broad and you could argue that "allowing" is basically a grant of permission which appears to be abstract. Thus, since there is a judicial exception, we need a practical application of the judicial exception, but the result of the claim is just permission to do certain things, this is arguably not tangible.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Art Unit: 3694

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-3 recite a "commercial paper product" which is not within any of the statutory classes of invention, and thus are rejected as being drawn to a non-statutory class of invention. These claims effectively set forth a legal agreement, certain relationships to secure the certificate and certain rights allowed to the bearer which does not fall within any of the statutory classes of invention including processes, machines, chemical compositions or articles of manufacture.

Claim 4 recites "allowing traders" to perform tasks. Examiner notes that the term "allowing" is basically a grant of permission which appears to be abstract. Thus, since there is a judicial exception we need a practical application of the judicial exception, not just permission to do certain things. Examiner further notes that this can be corrected by changing the "allowing" into applications such as "the step of buying or selling," "the step of accepting the stock," and "the step of converting the traded stock" respectively.

The disclosed invention is inoperative and therefore lacks utility.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1-2 are rejected under 35 U.S.C. 102(a) as being anticipated by "What Are Depository Receipts?" by Reem Heakal (hereinafter Heakal).

As per claim 1

Heakal discloses a commercial paper product for global stock trading in a common currency comprising a novel commercial paper document, to be called a Dollar Equivalent Stock Certificate (DESC) (depository receipt) secured by an individual or corporation which allows the bearer to convert the foreign currency stock price into its dollar equivalent and to pay the bearer of said dollar equivalent stock certificate (DESC) the U.S. dollar equivalent of the foreign shares owned (page 1, lines 1-6 and page 2, lines 8-46).

As per claim 2

Heakal discloses the stock value is secured by Euros (page 1, lines 29-31).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over by "What Are Depository Receipts?" by Reem Heakal (hereinafter Heakal) in view of "Free Banking Can Solve the Ruble Problem" by Annelise Anderson (hereinafter Anderson).

As per claim 3

Heakal discloses securing the stock value (page 1, lines 29-31).

Heakal does not specifically teach the stock value is secured by gold.

Anderson teaches the stock value (bank note) is secured by gold (abstract).

Examiner notes that gold can be universally traded in a "free market." The bank note as taught by Anderson could be backed by gold, making it very easy to trade.

Therefore it would have been obvious to one skilled in the art at the time the invention was made to incorporate the stock value is secured by gold as taught by Anderson to decrease fluctuation in value and utilize an already common currency.

Art Unit: 3694

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over by "What Are Depository Receipts?" by Reem Heakal (hereinafter Heakal) in view of US Patent Application Number US2002/0087454 to Calo et al. (hereinafter Calo).

As per claim 4

Heakal discloses allowing traders to accept the stock traded in its currency of origin with a dollar equivalent stock certificate (DESC) (depository receipt) by allowing the traded stock to be converted into its dollar equivalent, thereby creating a method of uniform trading for global securities in U.S. dollars (page 2, lines 8-46).

Heakal does not specifically teach a method for the uniform trading of foreign securities on their respective foreign stock exchanges comprising the steps of presenting all stocks from all stock exchanges (U.S and foreign), or a representation of the same, on an electronic trading system, comprising a server and trading platforms which are accessible to a plurality of traders wherein, said electronic trading system converts all foreign stocks from all foreign exchanges into their dollar equivalent allowing traders to buy and sell these foreign stocks on said electronic trading system in their dollar equivalent.

Calo teaches a method for the uniform trading of foreign securities on their respective foreign stock exchanges comprising the steps of presenting all stocks from all stock exchanges (U.S and foreign), or a representation of the same, on an electronic trading system, comprising a server and trading platforms which are accessible to a plurality of traders wherein, said electronic trading system converts all foreign stocks from all foreign exchanges into their dollar equivalent allowing traders to buy and sell these foreign stocks on said electronic trading system in their dollar equivalent (abstract).

Therefore it would have been obvious to one skilled in the art at the time the invention was made to incorporate a method for the uniform trading of foreign securities on their respective foreign stock exchanges comprising the steps of presenting all stocks from all stock exchanges (U.S and foreign), or a representation of the same, on an electronic trading system, comprising a server and trading platforms which are accessible to a plurality of traders wherein, said electronic trading system converts all foreign stocks from all foreign exchanges into their dollar equivalent allowing traders to buy and sell these foreign stocks on said electronic trading system in their dollar equivalent as taught by Calo to provide a platform for universal trading.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA L. LEMIEUX whose telephone number is

(571)270-3445. The examiner can normally be reached on Monday-Thursday 8AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/THOMAS A DIXON/
Supervisory Patent Examiner, Art Unit 3694

Jessica L Lemieux
Examiner
Art Unit 4172

February 2008